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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/327,107 | 06/07/1999 | BROOK LANG | LANB-101 | 5045 |

7590 03/25/2002

DEAN A CRAINE
CRAINE ASSOCIATES INC
400 112TH AVENUE N E SUITE 140
BELLEVUE, WA 98004

EXAMINER

LE, KHANH H

| | |
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| ART UNIT | PAPER NUMBER |
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2162

DATE MAILED: 03/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/327,107

Applicant(s)

LANG, BROOK

Examiner

Khanh H. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,7,13,14,16,17 and 19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,7,13,14,16,17 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Final Action

1. This Office Action is responsive to the Amendment mailed Dec. 5, 2001.

Claims 2, 6, 8-12, 15, 18, 20-22 have been cancelled as requested. (Claims 8-9 are confirmed cancelled orally by Mr. Craine, 03/19/2002 yet the clean copy of claims faxed 03/19/02 still shows claim 8 and 9. The examiner takes them as cancelled. Clarification is required in the next response to this Office Action.)

Claims 1, 3-4, 7, 13, 14, 16, 17, 19 are amended as requested.

Claims 1, 3-4, 5, 7, 13, 14, 16, 17, 19 are pending and herein examined. (Claim 5 is confirmed not cancelled orally by Mr. Craine, 03/19/2002).

Claim Rejections - 35 USC § 112(2)

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3.

- Claim 1 step d and e: Missing step
- Step d) should claim “selecting advertising material using said user file “before the transmitting step.
- Claim 4, dependent on claim 1, lacks of antecedent basis because it refers to “said wireless telephone (underline added) network” while there is no such terms recited in claim 1.
- Claim 16: lack of antecedent basis as referring to claim 15 which has been cancelled. It is assumed that claim 16 is dependent on claim 1.

Withdrawal of Previous Rejections

4. In view of the extensive amendments, the following are withdrawn :

- Rejections of Claims 1-2, 5-6, 8-11, 14-15, 18-22 under 35 U.S.C. 102(e) as being anticipated by Hidary, US 5822775
- Rejections of Claims 3-4, and 13 rejected under 35 U.S.C. 103(a) as being unpatentable over Hidary in view of Titmuss, WO 97/37500,
- Rejections of Claims 7 and 16-17 rejected under 35 U.S.C. 103(a) as being unpatentable over Hidary in view of Pepe et al, US 5673322, and Roth , WO 98/34189, hereinafter ‘Roth’.

Response to Arguments

5. As to Applicants' remarks, they are moot as new prior art is applied.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. **Claims 1,3-4, 5, 7, 13-14, 16-17,19 are rejected under 35 U.S.C. 103 as being unpatentable over Obradovich et al, US 6133853, hereinafter Obradovich, in view of Roth , WO 98/34189, hereinafter 'Roth'.**

Obradovich et al, US 6133853 teaches a personal communication device with GPS, monitored device and user physical location , and supply of information including ads (col 3 l. 25-44) based on user's monitored location, requests and indicated preferences, over wide area networks.

Obradovich also discloses

GPS cell phone (Fig 1 and associated text, esp. items 10 and 60)

local information including advertising (Fig 23A and associated text)

WWW (Fig 5D, Fig 37 esp. item 1246 , Fig39 and their associated texts) ;

commercial places (ads) (col 3 l. 25-44) which discloses GPS based mobile navigation cellular phone system based on user requests for navigation information including, etc...,

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continuous tracking of location and providing of information ;

ID of device location;

user activities consisting of :user requests for specific information (col 3 l. 1-24) , user input of destination; user transmitting specific information (Fig 37 and associated text); user/PCD previous locations as a basis for approving credit .

Thus , as for Claim 1, Obradovich disclosed :

A method of providing to a user of an electronic device connected via a wireless connection (Fig 1 and associated text, col 4 l. 15-31, col 2 ll. 18-43) to a computer wide area network (www, see above) comprising the following steps:

a. selecting an electronic device (Fig 1 item 20 and associated text) used to connect to said computer wide area network

b. selecting a server (Fig 37 and associated text: “central computer system” ; col. 2 l. 18-43) connected to said computer wide area network

c and d. determining the network identity (col 24 l. 37-col 25 l. 30 : PCD user requests credit, credit authorizer responds: it is well-known that network ID is needed to communicate with an e-device thus it is obvious to one skilled in the arts to deduce from Obradovich’s disclosures that the e-device network ID is used for “automatically transmitting data responsive to the requests” , see abstract;

(In the reference it is also disclosed “...For example, for many cases the central computer system may be the computer system identified by the Internet address. ...”)

physical location (col 24 l. 37-col 25 l. 30 : PCD user requests credit, credit authorizer determines previous and current location of the PCD for approval of credit)

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and said network connection activities of said electronic device when connected to said computer wide area network

(col 24 l. 37-col 25 l. 30 : PCD user requests credit, credit authorizer checks previous locations of user/PCD, previous requests from the PCD to determine eligibility, thus those previous locations and requests constitute activities of the e-device)

e. creating a user file containing said network identity of said electronic device, physical location information of said electronic device and said network connection activities of said electronic device when connected to said computer wide area network (in the credit request example above, all three types of data , network ID, physical location and connection activities are used to provide the information (credit approval) i.e. a group (file) of data regarding the user is used i.e. a "user file" is used)

f and g. selecting and transmitting said information including advertising material to said electronic device over said computer wide area network using said user file. (In the credit example above, Obradovich discloses selecting and transmitting a response to the request based on such user file. Other embodiments in this reference show other type of information being selected and sent on that basis, including ads , see e.g. col 3 l. 25-45, Fig 23A and associated text)

Further providing ads based on network connection activities is old as admitted ("Amendment" paper at 7 , l. 8-10) and as disclosed by Roth. (mentioned in last Office Action).

Indeed , Roth , WO 98/34189, discloses targeting of ads based on user activities when connected to the Internet is old (see p. 1 and 2). Roth further discloses the use of cookies for such targeting. (Fig 1 item 11 and 11a and related text).

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Thus one skilled in the arts would have known to combine Roth's ads targeting by connection activities and cookies teachings to that of Obradovich's to extend the extensive power of the Internet to better service the mobile user once wireless Internet devices technology becomes available.

Thus one skilled in the arts would have known to add such feature to Obradovich.

As for claims 3-4,5, 7,13-14,16-17,19, the method of claim 1 is as above-disclosed.

As for claim 3, Obradovich does disclose the step (b) of determining the location of said electronic device is accomplished using a global positioning satellite which provides global coordinate information of said electronic device when connected to said wide area network (the PCD location is updated as the mobile user moves : see e.g., “...*As the user's geographic location is updated through use of the PCD*, the home site computer system automatically maintains a list of active phone numbers, facsimile numbers, and e-mail addresses for the user. *Thus, if the user's geographic location as provided by the PCD....*” ; col 24 l. 37-col 25 l. 30 : PCD user requests credit, credit authorizer checks location of user/PCD and if consistent with previous location, credit is issued: this process involves transmission of data between the PCD and responses to/from a third party i.e. the physical location of the PCD/wireless computer inherently can be determined by the wireless telephone network when the PCD is thus connected for exchange of data)

Claim 4.

(Note: Applicants' representative, Mr. Dean Craine confirmed orally and by fax received on 3/19/02, that step c) and not step b) was involved in this claim.)

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Obradovich discloses step c) is carried out by a wireless modem connected to said electronic device and used to communicate with said wireless telephone network, (Obradovich discloses the PCD has computer(Fig 16) /fax/phone modes : Fig 2 and associated text, esp. item 29G, fax/phone modem; Fig 30 and associated text: dialing for services ; col 18 l.20 et seq.) ,

said wireless telephone network capable of determining the physical location of said wireless modem when connected to said wireless telephone network and moving throughout the region served by said wireless telephone network.

(the PCD location is updated as the mobile user moves : see e.g.,. *“...As the user's geographic location is updated through use of the PCD, the home site computer system automatically maintains a list of active phone numbers, facsimile numbers, and e-mail addresses for the user. Thus, if the user's geographic location as provided by the PCD....”* ; col 24 l. 37-col 25 l. 30 : PCD user requests credit, credit authorizer checks location of user/PCD and if consistent with previous location, credit is issued: this process involves transmission of data between the PCD and responses to/from a third party i.e. the physical location of the PCD/wireless computer inherently can be determined by the wireless telephone network when the PCD is thus connected for exchange of data)

as to ID's

“...In accordance with the present invention, the central computer system also maintains information in a database allowing individual users to be easily located both physically and in terms of their electronic communication locations. The central computer system maintains a database of individuals and an Internet address linked to each individual. The Internet address linked to each individual need not be a unique address, but instead many individuals may make use of a single computer indicated by the Internet address in the Internet address field. For example, for many cases the central computer system may be the computer system identified by the Internet address. ..”

Claim 5.

Obradovich further discloses a server (Fig and associated text:) connected to said computer wide area network (WWW , p. 6 2nd full para.), said server capable of receiving said identity and physical location information to create said user file (see above) .

Claim 7.

Obradovich does not disclose the step of determining the network connection activities of said electronic device is carried out by determining the existence of "cookies" on said electronic device. However , Obradovich discloses wireless electronic devices capable of Internet connections (also see, e.g., Pepe et al, US 5673322; admitted art ; Amendment at pages 7 l. 8-9) . Further , Roth , WO 98/34189, discloses targeting of ads based on user activities when connected to the Internet is old (see p. 1 and 2). Roth further discloses the use of cookies for such targeting. (Fig 1 item 11 and 11a and related text). Thus one skilled in the arts would have known to combine Roth's targeting by cookies teachings to that of Obradovich's to extend the extensive power of the Internet to better service the mobile user once wireless Internet devices technology becomes available.

As for claim 13, Obradovich discloses step (c) ("determining the network identity and physical location of the e-device) is carried out using information transmitted by said electronic device when connected to said computer wide area network. (Fig 1 and associated text: cell phone with GPS; col 4 l. 41-65: connection to cyberspace; also see discussion of claim 1, step c) above).

Claim 14. Obradovich discloses that said step (c) is carried out by a cellular telephone system capable of determining the physical location of a cellular telephone used to connect to

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said wide area network. (Fig 1 and associated text: cell phone with GPS ; also see discussion of claim 1, step c) above).

Claims 16 and 17 address Internet connections. Roth and Obradovich (see Fig 5D and associated text re. phones connected to the WWW), disclose such method as discussed in claim 7.

Further Official Notice is taken that the steps of identifying electronic devices when connecting to the Internet by determining the numerical address assigned to said electronic device by said server (claim 16) or by using client software (such as AOL) to transmit identification information (claim 17) are old. (Official Notice presented in last Office Action and not challenged)

Thus one skilled in the arts at invention time, would have known to use such known techniques to ID a user/device for more efficient ads delivery as taught by Obradovich in view of Roth.

Claim 19. Obradovich discloses wherein said server collects personal data of said user of said electronic device and adds it to said user file. (Fig 5A and associated text, especially item 141: preferences; since the computer system uses this data in addition to the others to send the information/ads , it in effect adds it to the user file).

Conclusion

8. Prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ads targeting:

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Roth , WO 98/34189, (august 1998) discloses Internet advertising bidding system whereby the viewers characteristics, are transmitted and targeted ads are delivered . This reference can be used to reject claims 5-7, 13-19.

Angles et al, US 5933811, discloses delivery of customized ads through Internet

Blinn et al., US 5999914, discloses Internet e-promotions by monitoring user activities (user e-shops triggering certain promotions and awards) , suggests systems will work with wireless systems and PDA's .

Wireless devices

Griffith, US 5812953, discloses cell phone ID tracking through the MTSO network (cols. 1 and 2)

Malackowski et al, US 5752186 (5/98) discloses wireless ID of user by access code

Park WO 96/04633, discloses targeted advertising to GPS tracking vehicle

Park WO 97/17774,, discloses selective advertising to GPS tracked vehicle

Mannings et al , WO 96/07110, (also US 6169515) discloses GPS (Fig 1 item 7) based mobile navigation cellular phone system based on user requests for navigation information including commercial places, etc..., continuous tracking of location and providing of information ; ID location; user activity :user requests info, user input destination.

Obradovich et al, US 6133853 teaches a personal communication device with GPS determined user location and supply of information including ads (col 3 l. 25-44) on user requests., network ID, physical location

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Tracy et al, 5979757, discloses wireless shopping device based on consumer activities. This ref. could be used to reject most claims.

Pepe et al, US 5673322, discloses connection of wireless devices to Internet

Hidary, US 5852775 discloses cellular phone advertising system w/ MTSO, cell ID, subscriber profiles, targeted messages

*Smith, US 5717374, discloses method for sending ads to vehicles while coupled to gas filling stations

* submitted by the Applicants as prior art

Bouve et al , US Pat 5682525 teaches a method for obtaining information on a mobile computing environment with the step of providing a list of merchants proximal to the mobile computing environment using GPS receiver. Ads are also provided.

Heron , US 6055478, teaches an integrated vehicle GPS based navigation, communication and entertainment system with Internet access.

Behr et al, US 5543789, discloses remote navigation system with queries and responses

Titmuss et al, WO 98/47295 , discloses a method for guiding a shopper on a mobile computing environment

Titmuss et al, WO 97/37500 , discloses a method for sending a format-compatible signal to an electronic device nearest the user upon tracking the user. (GPS cell phone, p. 8 l. 26-30; , network ID (p. 20 l. 33, p. 21 l. 1-2) at any time is tracked and stored , physical location) p. 8 l. 31-37) .

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A.E. Fano, Proceedings of the International Conference on Autonomous Agents, ACMAs for Shopper's Eye: using location-based filtering for a shopping agent in the physical world, by claim 15, "interfa, NY, NY, USA p. 416-421, conference date 05/09-13/1998. This article could be used in view of Hidary to reject some claims.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is (703) 305-0571. The examiner can normally be reached on Tues-Wed from 9:00 AM – 6:00 PM. The examiner can also be reached at the e-mail address: khanh.le2@uspto.gov

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. Facsimile transmissions to this Group (TC 2100) may be directed to :

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After-final (703) 746-7238


Official (703) 746-7239

Non-Official/Draft (703) 746-7240

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900 .

March²¹~~24~~, 2002

KHL *KHL*


ERIC W. STAMBER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100